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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,058	11/26/2003	Michael Roberts	NECW 20.768	8639

26304 7590 10/31/2006

KATTEN MUCHIN ROSENMAN LLP
575 MADISON AVENUE
NEW YORK, NY 10022-2585

EXAMINER

FIGUEROA, MARISOL

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/723,058	Applicant(s) ROBERTS, MICHAEL	
	Examiner Marisol Figueroa	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/12/2006 has been entered.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 8/21/2006 is being considered by the examiner.

Response to Arguments

3. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1-4, and 6** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the further sending operation" and "the sending operation" in lines 11-12. There is insufficient antecedent basis for this limitation in the claim.

Furthermore, the claim recites the limitations of “further sending to the network the measurements performed in step c) the further sending operation being performed in a message distinct from the sending operation” on lines 9-12. It is not clear if the sending operation refers to the step b or not. For purposes of examination the examiner interprets that the “sending operation” refers to the step b.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over LAITINEN et al. (US 2003/0189912 A1) in view of KALLIN et al. (US 5,701,585).

Regarding claim 1, Laitinen discloses a method of handover in a multimode mobile telecommunication network (P.0005, lines 1-6) in which, to initiate a handover, the network sends to a mobile terminal a first group of system information via a first channel associated with circuit switching services and a second group of system information via a second channel associated with packet switching services (P.0025; a dual-mode MS receives information of 3G neighbor Cell list in a SI2quarter message from the BCCH channel and a PSI3quarter message on the PBCCH channel), comprising the steps of:

a) performing measurements at least in one neighboring cell on a basis of information contained in the second group of system information (P.0026, P.0058, lines 1-10; the mobile station

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receives information from the network over the PBCCCH and construct a Neighbor Cell list and measures the cells contained in the list);

b) sending to the network the measurements performed in step a) (P.0058, lines 1-10; the MS reports the measurements to the network), and

e) initiating the procedure of handover according to the measurements performed in step a) (P.0005, lines 1-6; P.0019; the wireless network commands to the MS to perform handover if necessary).

Furthermore, Laitinen discloses wherein the network sends to the mobile terminal the first group of system information via the first channel after the performing measurements operation (P.0006-0007; P.0008, lines 1-6; P.0011; P.0022, lines 1-5; P.0025; when the mobile station transitions from a GPRS dedicated mode to a GSM dedicated mode, the MS immediately made measurements on packet system information (PSI3) received while in GPRS dedicated mode, then while the MS is in GSM dedicated mode, it receives system information (SI2) via a BCCH, i.e. first channel, corresponding to a first group of system information).

Laitinen does not expressly disclose the features of c) further performing measurements at least in one further neighboring cell on the basis of the information contained in the second group of system information, and further sending to the network the measurements performed in step c), the further sending operation being performed in a message distinct from the sending operation.

However, Kallin teaches a mobile assisted handoff for use in a cellular communication system in which the mobile station receives or is assigned a list of cells and measures the quality level of each assigned cell and regularly reports the measurements (i.e., different measurement reports) to the communication system. Also, teaches that a mobile station cannot measure all of the neighboring cells at the same time and if a good handoff candidate is not found the mobile station

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can perform further measurements until a good candidate handoff is found (col. 1, line 54-col. 2, lines 1-16; col. 3, line 67-col. 4, lines 1-30; col. 5, lines 14-44).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention, the features of step c) further performing measurements at least in one further neighboring cell on the basis of in the second group of system information, and further sending to the network the measurements performed in step c), the further sending operation being performed in a message distinct from the sending operation, as suggested by Kallin, because it is conventionally well known that in a mobile assisted handoff (as used in Laitinen) a mobile terminal regularly measure and reports (i.e., distinct messages) the quality level of each of the cells assigned to the mobile terminal in order to find a good candidate for handoff.

Regarding claim 2, the combination of Laitinen and Kallin disclose the method according to claim 1, Laitinen discloses wherein the measurements in a neighboring cell based on information contained in the first group of system information associated with circuit switching services (P.0005, lines 1-4; P.0006, lines 10-17; in the GSM dedicated mode, i.e. circuit switched connection, the MS receives system information (SI2), corresponding to a first group of system information, over a BCCH channel).

Regarding claim 3, the combination of Laitinen and Kallin disclose the method according to claim 2, Laitinen discloses wherein the telecommunication network is a GSM/GPRS network (P.0019; it is inherent to recognize that the telecommunication network is a GSM/GPRS network since the MS is dual mode GSM/UMTS and compatible with a GPRS network), and wherein the first channel is a BCCH channel and the second channel is a PBCCCH channel (P.0025; the MS receives a SI2quarter message from a BCCH channel and a PSI3quarter message from a PBCCCH channel).

Regarding claim 4, the combination of Laitinen and Kallin disclose the method according to claim 2, Laitinen discloses wherein the telecommunication network is a UMTS network (P.0019, lines 1-3; it is inherent to recognize that the telecommunication network is also a UMTS network because the MS station is a dual mode terminal compatible with a multimode network, i.e. GSM, GPRS, and UMTS).

Regarding claim 5, Laitinen discloses a mobile terminal used in a multimode mobile telecommunication network (P.0019, lines 1-3), the mobile terminal performing measurements for preparing for a handover in the network, the measurements depending either on a first group of system information sent by the network to the mobile terminal via a circuit switching channel or on a second group of system information sent by the network to the mobile terminal via a packet switching channel, the mobile terminal comprising:

means for performing measurements at least in one neighboring cell on a basis of information contained in the second group of system information, means for sending to the network the measurements performed (P.0058, lines 1-10; is inherent to recognize that the mobile terminal has means for performing measurements of cells and means for sending these measurements to the network since it performs these procedures), and

means for initiating the procedure of handover according to the measurements performed (P.0005, lines 1-6; the MS measures and send the reports of measurements to the network and this enables the network to command a handover if it is determine from the measurements that a handover is necessary).

Furthermore, Laitinen discloses wherein the network sends to the mobile terminal the first group of system information via the first channel after the performing measurements operation (P.0006-0007; P.0008, lines 1-6; P0011; P.0022, lines 1-5; P.0025; when the mobile station transitions

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from a GPRS dedicated mode to a GSM dedicated mode, the MS immediately made measurements on packet system information (PSI3) received while in GPRS dedicated mode, then while the MS is in GSM dedicated mode, it receives system information (SI2) via a BCCH, i.e. first channel, corresponding to a first group of system information).

Laitinen does not expressly disclose wherein the mobile terminal comprises further means for performing further measurements at least in one further neighboring cell on the basis of information contained in the second group of system information, further means for sending to the network the further measurements performed, wherein the further measurements are sent in a message distinct from the sending of the measurements.

However, Kallin teaches a mobile assisted handoff for use in a cellular communication system in which the mobile station receives or is assigned a list of cells and measures the quality level of each assigned cell and regularly reports the measurements (i.e., different measurement reports) to the communication system. Also, teaches that a mobile station cannot measure all of the neighboring cells at the same time and if a good handoff candidate is not found the mobile station can perform further measurements until a good candidate handoff is found (col. 1, line 54-col. 2, lines 1-16; col. 3, line 67-col. 4, lines 1-30; col. 5, lines 14-44).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention, wherein the mobile terminal comprises further means for performing further measurements at least in one further neighboring cell on the basis of information contained in the second group of system information, further means for sending to the network the further measurements performed, wherein the further measurements are sent in a message distinct from the sending of the measurements, as suggested by Kallin, because it is conventionally well known that in a mobile assisted handoff (as used in Laitinen) a mobile terminal regularly measure and reports (i.e.,

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distinct messages) the quality level of each of the cells assigned to the mobile terminal in order to find a good candidate for handoff.

Regarding claim 6, the combination of Laitinen and Kallin disclose the method according to claim 1, Laitinen discloses wherein the means for performing measurements is adapted to perform the measurements immediately upon receipt of the second group of system information (P.0058; the MS immediately perform measurements on system information received over the PBCCH when enters the GSM dedicated mode).

Regarding claim 7, the combination of Laitinen and Kallin Laitinen disclose the mobile terminal according to claim 5, Laitinen discloses wherein the means for performing measurements is adapted to perform the measurements immediately upon receipt of the second group of system information (P.0058; the MS immediately perform measurements on system information received over the PBCCH when enters the GSM dedicated mode).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marisol Figueroa whose telephone number is (571) 272-7840. The examiner can normally be reached on Monday Thru Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Marisol Figueroa
Art Unit 2617


LESTER G. KINCAID
SUPERVISORY PRIMARY EXAMINER